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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,649	02/29/2000	Kiyoshi Toyoda	P19157	2077

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EXAMINER

JONES, DAVID

ART UNIT PAPER NUMBER

2622

DATE MAILED: 05/06/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/514,649

Applicant(s)

TOYODA, KIYOSHI

Examiner

David L Jones

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 18, 20-22, 24-26 and 28-35 is/are rejected.
- 7) ☒ Claim(s) 19, 23, and 27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed on 2/20/2004 has been received and made of record. Claims 1-16 has been cancelled, and new claims 17-35 have been entered.

Response to Arguments

2. Applicant's arguments, see page 9, filed 2/20/2004, with respect to the specification have been fully considered and are persuasive. The objection of specification has been withdrawn.
3. Applicant's arguments, see page 17, filed 2/20/2004, with respect to claims 1-16 have been fully considered and are persuasive. The objection of claims 1-16 has been withdrawn.
4. Applicant's arguments with respect to claims 17-35 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

5. Claims 19, 23, and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 17-18, 24-25, 28-29, 33-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Freeman (US 6,020,980).

Regarding claims 17, 24, 28, 33, Freeman discloses an image communication apparatus comprising:

a receiver (fig. 1, # 120, column 7, lines 28-33) configured to receive image data from a transmitting facsimile #112 apparatus via a public switched phone network #114; and

a controller (column 7, lines 57-67 and column 8, lines 1-14) configured to: convert the received image data to data for Internet transmission; attach the converted data to an e-mail; and

transmit the e-mail (column 9, lines 34-53) to a management center (email server #132), the management center configured to manage information that the image communication apparatus receives and further configured to connect to the image communication apparatus via the Internet.

Regarding claims 18, 25, 29, and 34, Freeman discloses an image communication apparatus, wherein the management center (column 9, lines 34-53) is configured to store information that the image communication apparatus receives, it is inherent that an administrator or supervisor of an email server would have access to the information within a email server or management center.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori (US 6,470,379).

Regarding claims 20 and 30, Mori teaches (fig. 3, column 6, lines 36-67 and column 7, lines 1-13) a communications system that includes:

a group-3 fax #107, includes a scanner #5, and a manipulation display #7, for inputting a destination address;

a controller configured (column 7, lines 57-67 and column 8, lines 1-12) to:

convert the received image data to data for internet transmission, attach the converted data to an email, and transmit the email to a mail server (management center) which can include any address the user wishes to input as is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that a user can input as many addresses at a time. Further as shown in figure 2, the system connects with both the PSTN and Internet through a LAN system and as detailed in column 7, lines 7-13.

Regarding claims 21 and 31, Mori teaches (fig. 3, column 6, lines 36-67 and column 7, lines 1-13) a communications system, it would have been obvious to one of ordinary skill in the art at the time the invention was made that an email server can be configured to store all emails

sent through the device and that an administrator or supervisor of an email server would have access to the information within a email server or management center.

Regarding claims 22, 32, and 35, Mori teaches (fig. 3, column 6, lines 36-67 and column 7, lines 1-13) a communications system, in column 8, lines 13-21 that the user inputs information on the destination using the one-touch key, the destination information such as the mail address of the destination user. It would have been obvious to one of ordinary skill in the art at the time the invention was made that the system can be setup to always send a BCC copy of all outgoing mail to a particular address within an outgoing mail server, or automatically create a copy as the email comes through the server.

Regarding claim 26, Mori teaches (fig. 3, column 6, lines 36-67 and column 7, lines 1-13) a communications system, in column 8, lines 13-21 that the user inputs information on the destination using the one-touch key, the destination information such as the mail address of the destination user. It would have been obvious to one of ordinary skill in the art at the time the invention was made that the user can input a destination of particular address such as a management center or mail server.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L Jones whose telephone number is (703) 305-4675. The examiner can normally be reached on Monday - Friday (7:00am - 3:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David L. Jones



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